

DETAILED ACTION

1. Receipt of Applicant's amendment and response filed December 5, 2008 is acknowledged.

Response to Amendment

2. Claims 2, 9, 12, and 16 have been amended. Claims 1, 4-5 and 10-11 are canceled. Claims 2-3, 6-9 and 12-16 are pending in the application and are provided to be examined upon their merits.

Response to Arguments

3. Applicant's arguments with respect to claims 2-3, 6-9, and 12-16 have been considered but are moot in view of the new ground(s) of rejection. Nevertheless, the Examiner provides a response below in **bold** where appropriate.

Applicant argues 35 USC 101 rejection to claims 1, 9-11, and 16, pg. 6 of remarks:

Rejections under 35 U.S.C. § 101

In the Office Action on page 19, item 4, claims 1, 9-11 and 16 are rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. While the applicable standard is no longer whether the claims produce "useful, concrete, and tangible results," the claims are amended and do transform a tangible object. (See *in re Bilski*, slip op. pages 19-20 and 10, (Fed. Cir. 2008)). For instance claim 2 recites "instructing delivery and/or settlement of an item from the managing apparatus depending on the commercial transaction and the confirmation, based on the real personal information." In other words, a tangible good is delivered to a real address based on the commercial transaction. Thus withdrawal of the rejection is requested.

The Examiner concurs and withdraws the rejection of claims 1, 9-11, and 16 under 35 USC 101. Claim 1 is withdrawn as the rejection is moot since the claim was canceled.

Regarding the above Bilski ruling brought up by Applicant, the Office is now requiring that method steps be tied to another statutory category, where such steps are considered non-trivial. Therefore, while not every step needs to be tied to an apparatus, non-trivial steps should be, otherwise they may be considered abstract. The Examiner notes the current amended claims have a network for communicating tied to some method steps. Should it be determined in the future that other steps are critical to the invention, an apparatus will have to be tied to the step(s). For example, claim 2, as it stands, has many steps that lack an apparatus of some type. Hardware for a “managing apparatus” cannot be found in the specification by the Examiner, therefore, if Applicant plans to rely on “managing apparatus” as a system tie to the non-trivial method steps, the Applicant needs to indicate support in the specification for the hardware structure making up the managing apparatus.

Applicant argues 35 USC 112, 2nd paragraph rejection:

Rejections under 35 U.S.C. § 112, second paragraph

In the Office Action on page 20, item 6, claims 1-8 and 16 are rejected under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. The claims are amended and withdrawal of the rejection is requested.

The Examiner withdraws the rejection to claims 1-8 and 16 based on the amendments.

In the Office Action on page 20, item 7, claims 12-15 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 is amended and withdrawal of the rejection is requested.

The Examiner withdraws the rejection to claims 12-15 based on the amendment.

The Examiner notes Applicant has further invoked “means-plus-function” language in claim 9. The specification must contain steps to support such language. The Examiner provides a 35 USC 112, 2nd paragraph rejection, requesting Applicant to provide support for such use in the specification. Further, claim elements using means for language must not be modified by structure in the element. For example, “transaction means for making a commercial transaction in the virtual world on the network...” specifies a structure (network) in the means plus function language.

Applicant argues 35 USC 103(a) rejection:

Rejections under 35 U.S.C. § 103(a)

In the Office Action, on page 21, item 10, claims 1-5 and 8-16 are rejected under

35 U.S.C. § 103(a) as being unpatentable over Shiloh provisional Application 60/191625 and Ferreira (2001/003466t). This rejection is respectfully traversed below.

Applicant argues secondary reference Ferreira prior art, starting pg. 6:

As discussed in the Personal Interview on November 25, 2008, the Ferreira publication (2001/0034661) is disqualified as a reference because the Applicants have perfected a claim for Serial No. 10/046,498 priority by filing the certified English translation of the priority document which is dated January 17, 2001. Because the Office Action bases its rejection of the claims on paragraphs found in the above reference, this rejection is respectfully traversed. Only Ferreira's provisional application may be used as a prior art reference against this Application. Thus, the Examiner may only rely on what is disclosed in the provisional application.

With all due respect, support must exist in the provisional regarding pertinent material for a non-provisional application to have the benefit of the earlier filing date and to be used as a reference. Support was found by the Examiner in Ferreira's provisional application that rendered the non-provisional valid prior art. A rejection using a provisional application as a reference is normally not provided since this is not published material. Nevertheless, the Examiner will reference the provisional to highlight the support if required.

The Examiner requests the Applicant to provide support for this requirement, which is asserted by Applicant:

"Only Ferreira's provisional application may be used as a prior art reference against this Application."

The Examiner is unable to find this requirement stated anywhere that provisional's are required prior art. as a reference.

Applicant argues Shiloh, pg. 7 of remarks:

The provisional Shiloh application discusses providing virtual users with buying power in the form of a virtual spending account with Virtunality to purchase products and services. Virtunality will provide users with a fictional user name and fictional user information to keep internet activity private. Virtunality notes that most products and services on the Internet do not require real world addresses including print your own products like bar coded stamps, movie tickets, music, videos, and hotel reservations. However, Virtunality does note that products only available via shipping will be sent to physical P.O. boxes established by Virtunality for a monthly fee. (See Shiloh, page 2, lines 1-5; page 3, lines 5-8; page 5, lines 1-8 and Proposed Model for Virtunality).

With all due respect, Virtunality ships to a physical PO Box, therefore real world items must be sent to the box.

Applicant argues Ferreira, pg. 7 of remarks:

The provisional Ferreira application discusses a method and system for presenting a virtual representation of an actual city such as New York. In this virtual city, the user is provided a one-stop-shopping destination having merchandise from large e-commerce sites as well as local vendors, Ferreira's virtual cities are designed such the user need only enter their sensitive credit card information one time. However, this actual credit card information is sent over a network and used to make purchases. Thus, actual information is sent during each purchase. Ferreira's one-stop-shop merely provides that shoppers enter their personal information once. When a purchase is made, an e-mail with credit card information and the actual name is sent to a warehouse shipper as well as to VirtuaCities and VirtuaCities processes payment. Furthermore, Ferreira discusses that it will sell purchaser information to retail companies to help them market their goods and purchasers will receive sales solicitations based on their past purchases. (See Ferreira, page 2, paragraph 2; page 6, Web-Surfers Bullet List; page 8, paragraph 3; page 12, paragraphs 2-4; pages 18-19, Marketing Services). The Office Action, on page 23, admits that Shiloh does not teach registered information. However, the Office Action asserts that paragraph [0085] of the Ferreira publication teaches registered information.

In this instance, Ferreira was used to teach a virtual city and registered information. It is respectfully unclear to the Examiner how Ferreira fails to teach a virtual city.

This paragraph merely indicates that Ferreira provides a one-stop-shopping destination. However, as discussed above, this reference is disqualified. Although Ferreira's provisional also discusses one-stop-shopping on page 8, as described above, "registration" in Ferreira is related to providing actual information including sensitive credit card information to VirtualCities, not Serial No. 10/046,498 "converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network" as recited in claim 2. Thus, Ferreira is not concerned with protecting a user's information because actual credit card information is sent over a network during every purchase and furthermore, Ferreira's ultimate goal discusses selling its customers' actual personal information. Thus, one of ordinary skill in the art at the time of the invention would not have been motivated to combine Shiloh's provisional application with Ferreira's provisional application to teach "converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network." Thus, claim 2 patentably distinguishes over Shiloh's provisional application and Ferreira's provisional application, either alone or in combination.

From above...

Thus, Ferreira is not concerned with protecting a user's information because actual credit card information is sent over a network during every purchase and furthermore, Ferreira's ultimate goal discusses selling its customers' actual personal information.

With all due respect, nobody sends actual credit card information over the Internet. Ferreira teaches specifically:

"The most powerful form of local e-commerce is what we call "one-stop local e-commerce." It is based upon the proposition that e-shoppers dislike filling out registration forms and credit card payments over and over as they visit different sites. It is tiresome, intrusive, and potentially risky. One-stop local e-commerce, then, necessitates that, barring changes in their personal information, e-shoppers need fill out only one registration form. Sensitive credit card information need be submitted only one time, and to only one place. The consumer saves time and only needs to place trust in one counter-party." (60/182282, pg. 8, para. 4)

Further, nothing cited by the Office Action or found in either reference teaches or suggests "seeking confirmation on an approval of the commercial transaction from an individual in the real world who made the commercial transaction, based on the virtual personal information." In other words, a real person is contacted while keeping their real information from the seller. The real person is asked to confirm their purchase and if the confirmation occurs, then the method continues by "instructing delivery and/or settlement of an item from the managing apparatus depending on the commercial transaction and the confirmation, based on the real personal information." In particular, nothing in either reference teaches seeking confirmation from an individual to deliver an actual item through the mail while keeping the user's actual information protected. Thus, claim 2 patentably distinguishes over Shiloh's provisional application and Ferreira's provisional application, either alone or in combination.

The Applicant has amended the prior claim. The Examiner provides a response to the amended claims in the rejection below.

Applicant argues claim 9, pg. 8 of remarks:

Claim 9, as amended, recites "converting means for converting the virtual personal information received from the virtual city within the virtual world via a network into corresponding real personal information of the real world, based on the registered information" and "means for seeking confirmation on an approval of the commercial transaction from an individual in the real world who made the commercial transaction in the virtual world in which the virtual personal information is used, based on the virtual personal information." Claim 9

patentably distinguishes over Shiloh's provisional application and Ferreira's provisional application, either alone or in combination.

The Applicant has amended the prior claim. The Examiner provides a response to the amended claims in the rejection below.

Applicant argues claims 12, 16, and dependent claims below:

Claim 12, as amended, recites "a manager mapping virtual information to real personal information of a virtual world to real personal information" and "an approval of the transaction is sent by an individual in the real world who made the commercial transaction, based on the virtual personal information." Claim 12 patentably distinguishes over Shiloh's provisional application and Ferreira's provisional application, either alone or in combination.

Claim 16, as amended, recites "managing registered information of the virtual user and real user to convert virtual information into real information of a person,""seeking confirmation of the transaction from the real user; and and delivering an item involved in the commercial transaction to the real user if the real user confirms the transaction." Claim 16 patentably distinguishes over Shiloh's provisional application and Ferreira's provisional application, either alone or in combination.

Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner provides a new rejection based on the amended claims below.

The dependent claims depend from the above-discussed independent claims and are patentable over the cited references for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the cited references. For example, claim 14 and claim 15 recite "a virtual station through which the first virtual individual can move to another virtual city space." Thus, a real user may make a commercial transaction in one virtual city space using virtual information and move to another city space and make another commercial transaction in the other city space. (See "virtual station" as depicted in Figure 9 of the Application.) In particular, the cited references do not teach city spaces that are interconnected via stations. Ferreira merely discusses development of isolated virtual cities, it is submitted that the dependent claims are independently patentable over the cited references.

The Examiner provides a new rejection based on the amended claims below.

Official Notice Taken in Previous Office Action

As Applicant failed to traverse the Examiner's assertion of Official Notice the common knowledge or well-known art statement is taken to be admitted prior art (MPEP 2144.03 C):

“...Examiner takes Official Notice that logging into a virtual world such as logging onto the Internet is old and well known. Therefore, it would have been obvious to one skilled in the art at the time of invention to require logging into a virtual world, and that enhance the anonymity on the Internet of a user of Shiloh's Virtunality.” (prior Office Action)

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art (see 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”) (emphasis added)

Examiner Request

4. The Applicant is requested to indicate where in the specification there is support for amendments to claims should Applicant amend. The purpose of this is to reduce potential 35 U.S.C. §112, 1st and 2nd paragraph issues that can arise when claims are amended without support in the specification. The Examiner thanks the Applicant in advance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-3, 6-9, and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 2 has "notifying the real personal information to an entity..." where there is no indication how notification occurs or by who. For example, a person could notify by phone. The Examiner interprets this to mean a person can notify, which makes this step abstract.
8. Claim 2 has "seeking confirmation on an approval..." which is indefinite because seeking could be many things. The Examiner interprets this to mean receiving confirmation of an approval.
9. Claim 3 is rejected because it does not further limit claim 1.
10. Claim 9 uses means for language to invoke 35 USC 112, 6th paragraph (means-plus-function). However, use of means for language is only appropriate if support is found in the specification. In the instant case, a managing apparatus for example has a means for seeking confirmation on an approval of the commercial transaction. The specification needs to teach the steps showing the apparatus that accomplishes the confirmation. If steps exist in the specification for use of the means for language, the Examiner request Applicant to provide the location in the specification. Also, structure must not be provided in the claim element using means for language. For example, "transaction means for... on the network..." modifies the means for language by a network structure.

11. Claim 12 has: "a manager mapping virtual personal information..."; "an approval of the transaction..."; and "a delivery and/or settlement..." where no system hardware and software are included that provides the system capability to map, approve and deliver.

12. Claims 3, 6-8, and 13-15 are rejected because they depend from their respective independent claim.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 2-3, 6-9, 12-13, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No. US 2003/0069857 to Junda (and it's related parent application 09/693,165, which is also cited) in view of US Pub. No. 2001/0037316 to

Shiloh (and its provisional application 60/191625, which is used as the reference below).

Regarding claim 2:

An electronic commercial transaction method,
comprising:
creating virtual personal information;

Junda teaches:

“Before making purchases and/or taking delivery of goods or services, the user obtains proxy personal information for use in place of the user's real personal information during the purchase and/or delivery transactions.”
[0010] (pg. 4, lines 7-10 of 09/693,165)

“If it is determined, for example, that the user 120 is the holder of a credit or debit card issued by the proxy agent 140, payments have been timely made, and there are funds available on the credit or debit card, then the software on the proxy agent site 142 generates, in block 204, unique proxy user data corresponding with the user's real name, real shipping address, real credit or debit card account number, and real e-mail address, and then provides the generated proxy user data to the user 120 for subsequent use.” [0044] (pg. 12, lines 28-33 of 09/693,165)

(see Virtual below)

communicating to a manager, via a network, the virtual personal information of a virtual world having a representation format similar to that of real personal information of a real world;

“Before making purchases and/or taking delivery of goods or services, the user obtains proxy personal information for use in place of the user's real personal information during the purchase and/or delivery transactions.”
[0010] (pg. 4, lines 7-10 of 09/693,165)

“Further, the proxy agent site 142 can communicate with the user computer 122, the merchant site 132, the delivery computer 152, and the card issuer computer 172, and pass data back and forth during the purchase and delivery transactions.” [0038] (pg. 11, lines 3-6 of 09/693,165)

converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network;

“Finally, the software on the proxy agent site 142 updates, in block 206, the user database 144 to include the generated proxy user data and ensure that the generated proxy user data accurately corresponds with the real user data, which is also stored in the database 144 for facilitating translations

between the generated proxy user data and the real user data.” [0046] (pg. 13, lines 19-23 of 09/693,165)

notifying the real personal information to an entity;

“If it is determined, for example, that the user 120 is the holder of a credit or debit card issued by the proxy agent 140, payments have been timely made, and there are funds available on the credit or debit card, then the software on the proxy agent site 142 generates, in block 204, unique proxy user data corresponding with the user's real name, real shipping address, real credit or debit card account number, and real e-mail address, and then provides the generated proxy user data to the user 120 for subsequent use.” [0044] (pg. 12, lines 28-33 of 09/693,165)

making a commercial transaction in the virtual world on the network, based on the virtual personal information of the virtual world received via the network;

“It would therefore be desirable to have a system and a method for making on-line purchases and taking delivery of the purchases that keeps customers' personal information confidential and secure throughout the purchase or purchase and delivery transactions, while still allowing customers and merchants to communicate with each other over the public network without undue interference from any third party.” [0009] (pg. 3, lines 4-12 of 09/693,165)

seeking confirmation on an approval of the commercial transaction from an individual in the real world who made the commercial transaction, based on the virtual personal information;

and

“In addition, it was described that a message is generated and sent from the merchant site directly to the user computer for confirming a purchase transaction. However, this is also merely one illustrative example. The purchase confirmation generated at the merchant site might alternatively pass through the proxy agent site before being sent to the user computer. As a result, the proxy agent would be able to maintain a record of the purchase transaction and store the record in the user database along with the user's real data and proxy data. The user may then access these records for keeping track of his or her purchases made using the proxy user data.” [0076] (also pg. 21, lines 17-24 of 09/693,165)

instructing delivery and/or settlement of an item from the managing apparatus depending on the commercial transaction and the confirmation, based on the real personal information,

“The present invention also provides the user with a method for effecting the delivery of the goods or services that conceals the user's real residential or shipping address and/or e-mail address from the merchant.

In this embodiment of the present invention, the merchant may deliver goods or services in digital form to the user by utilizing the user's proxy e-mail address. Further, the merchant may deliver goods or services in tangible form to the user by providing the user's proxy residential or shipping address to an accepted delivery service, which obtains the user's corresponding real residential or shipping address and then delivers the goods or services to the user." [0014] (pg. 5, lines 11-18)

wherein said virtual personal information having a representation format similar to that of real personal information of a real world, and includes a virtual address in a virtual city within the virtual world.

"The user's personal information may include, but is not limited to, the user's real name, real residential or shipping address, real e-mail address, and real credit or debit card account number. Before making purchases and/or taking delivery of goods or services, the user obtains proxy personal information for use in place of the user's real personal information during the purchase and/or delivery transactions." [0010] (pg. 4, lines 5-10 of 09/693,165)

(see Virtual below)

Virtual

Junda teaches real information and non-real, proxy information for use with merchants over the internet, where such real and proxy information includes a user, address and city. The proxy information is the same as Applicant's virtual information, where "...

"....virtual personal information having a representation format similar to that of real personal information of a real world; and converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network." ([0014] of US Pub 2002/0095375)

Junda does not teach a virtual world with virtual information.

Shiloh, also in the business of teaching real and non-real information, teaches virtual, virtual world and virtual information:

"Virtunality will provide you with a fictional user name and fictional user information for your Internet activity. This implementation is intended for extremely privacy-oriented users who would not disclose their real identity to anyone related to the Internet, not even to Virtunality." (pg. 3, para. 1)

“According to another possible implementation (user type "Y" in the attached drawing), your real identity will be disclosed only to Virtunality in the real world, e.g., in person, by mail, by phone, by direct connection, etc. (depending on your level of comfort).” (pg. 3, para. 2). Therefore, Virtunality is an entity that receives real personal information.

The sole difference between Junda and the claimed subject matter is that the primary reference does not disclose a virtual world and virtual information including user, address, and city, rather proxy information that can be used online.

Shiloh discloses “virtual” in regards to user information and a virtual world, where such information is used in commerce and for shipping.

Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of virtual world in Shiloh for proxy information in Junda that includes address and city.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

While the Examiner provided prior art to all the steps, the Examiner gives no patentable weight to the following abstract steps which can be performed by a person: step 1 “creating virtual personal information; step 3 “converting the virtual personal information...” since a managing apparatus does not have hardware to perform the converting”; step 4 “notifying the real...”; step 6 seeking confirmation on an approval...”; step 7 “instructing delivery...”.

Regarding claim3

The electronic commercial transaction method as claimed in claim 2, further comprising: converting the virtual personal information into the real personal information in a managing apparatus provided in the network.

Junda teaches:

“Finally, the software on the proxy agent site 142 updates, in block 206, the user database 144 to include the generated proxy user data and ensure that the generated proxy user data accurately corresponds with the real user data, which is also stored in the database 144 for facilitating translations between the generated proxy user data and the real user data.” [0046] (pg. 13, lines 19-23 of 09/693,165)

Regarding claim 6:

The electronic commercial transaction method as claimed in claim 2, further comprising: approving log-in to the virtual world; and

Junda teaches:

“Next, the merchant 130 logs onto the authorization network 112, in block 304, for requesting authorization to charge the user's credit or debit card account for the selected purchase.” [0056] (pg. 16, lines 4-6 of 09/363165)

approving the commercial transaction in the virtual world.

“Alternatively, if the proxy agent 140 is not the bank or other institution that issued the credit or debit card to the user 120, then the software on the proxy agent site 142 translates the proxy user data into the corresponding real user data, e.g., the real credit or debit card account number, utilizing the user database 144, substitutes the proxy user data in the authorization request with the corresponding real user data, and then routes the authorization request to the card issuer 170 over the authorization network 112.” [0057] (pg. 16, lines 16-21 of 09/363165)

“A message including a purchase confirmation is then sent, in block 308, from the merchant site 132 to the user computer 122 directly or via the proxy e-mail address over the Internet 110. The message may also include a delivery confirmation, e.g., a shipping or delivery tracking number.” [0058] (pg. 16, lines 28-31 of 09/363165) Inherent in delivery confirmation is approval of the commercial transaction.

Regarding claim 7:

The electronic commercial transaction method as claimed in claim 6, wherein said approving the log-in and said approving the commercial transaction, respectively, approve based solely on the virtual personal information.

Junda teaches:

“Alternatively, if the proxy agent 140 is not the bank or other institution that issued the credit or debit card to the user 120, then the software on the proxy agent site 142 translates the proxy user data into the corresponding real user data, e.g., the real credit or debit card account number, utilizing the user database 144, substitutes the proxy user data in the authorization request with the corresponding real user data, and then routes the authorization request to the card issuer 170 over the authorization network 112.” [0057] (pg. 16, lines 16-21 of 09/363165)

Regarding claim 8:

The electronic commercial transaction method as claimed in claim 2, wherein said virtual personal information further includes at least one of a virtual name used in the virtual world, a virtual telephone number at the virtual address in the virtual city, a virtual

bank account number of a virtual bank within the virtual city, and a virtual credit card number of a virtual credit card usable in the virtual world.

Junda teaches:

"If it is determined, for example, that the user 120 is the holder of a credit or debit card issued by the proxy agent 140, payments have been timely made, and there are funds available on the credit or debit card, then the software on the proxy agent site 142 generates, in block 204, unique proxy user data corresponding with the user's real name, real shipping address, real credit or debit card account number, and real e-mail address, and then provides the generated proxy user data to the user 120 for subsequent use." [0044] (pg. 12, lines 28-33 of 09/693,165)

Regarding claim 9:

A managing apparatus, comprising:

managing means for managing registered information which is used when converting virtual personal information into real personal information of a virtual world of a real world, said virtual personal information having a representation format similar to that of the real personal information and including a virtual address in a virtual city within the virtual world;

Junda teaches:

"As mentioned above, the system 100 allows a user to make purchases and take delivery of goods or services while keeping some or all of the user's personal information confidential and secure throughout the purchase and delivery transactions. To this end, the proxy agent site 142 includes at least one user database 144 for storing not only the user's personal information such as his or her real name, real shipping address, real e-mail address, and real credit or debit card account number, but also corresponding proxy data such as a proxy name, a proxy shipping address, a proxy e-mail address, and a proxy credit or debit card account number." [0039] (pg. 11, lines 11-18 of 09/693,165)

(see Virtual below)

converting means for converting the virtual personal information received from the virtual city within the virtual world via a network into corresponding real personal information of the real world, based on the registered information;

"Finally, the software on the proxy agent site 142 updates, in block 206, the user database 144 to include the generated proxy user data and ensure that the generated proxy user data accurately corresponds with the real user data, which is also stored in the database 144 for facilitating translations between the generated proxy user data and the real user data." [0046] (pg. 13, lines 19-23 of 09/693,165)

notifying means for notifying the real personal information to an entity;

“If it is determined, for example, that the user 120 is the holder of a credit or debit card issued by the proxy agent 140, payments have been timely made, and there are funds available on the credit or debit card, then the software on the proxy agent site 142 generates, in block 204, unique proxy user data corresponding with the user's real name, real shipping address, real credit or debit card account number, and real e-mail address, and then provides the generated proxy user data to the user 120 for subsequent use.” [0044] (pg. 12, lines 28-33 of 09/693,165)

transaction means for making a commercial transaction in the virtual world on the network, based on the virtual personal information of the virtual world received via the network;

“It would therefore be desirable to have a system and a method for making on-line purchases and taking delivery of the purchases that keeps customers' personal information confidential and secure throughout the purchase or purchase and delivery transactions, while still allowing customers and merchants to communicate with each other over the public network without undue interference from any third party.” [0009] (pg. 3, lines 4-12 of 09/693,165)

means for seeking confirmation on an approval of the commercial transaction from an individual in the real world who made the commercial transaction in the virtual world in which the virtual personal information is used, based on the virtual personal information; and

“In addition, it was described that a message is generated and sent from the merchant site directly to the user computer for confirming a purchase transaction. However, this is also merely one illustrative example. The purchase confirmation generated at the merchant site might alternatively pass through the proxy agent site before being sent to the user computer. As a result, the proxy agent would be able to maintain a record of the purchase transaction and store the record in the user database along with the user's real data and proxy data. The user may then access these records for keeping track of his or her purchases made using the proxy user data.” [0076] (also pg. 21, lines 17-24 of 09/693,165)

means for instructing delivery and/or settlement of an item depending on the commercial transaction which is made in the virtual world in which the virtual personal information is used, based on the real personal information and the confirmation.

“The present invention also provides the user with a method for effecting the delivery of the goods or services that conceals the user's real residential or shipping address and/or e-mail address from the merchant. In this embodiment of the present invention, the merchant may deliver goods or services in digital form to the user by utilizing the user's proxy e-mail address. Further, the merchant may deliver goods or services in

tangible form to the user by providing the user's proxy residential or shipping address to an accepted delivery service, which obtains the user's corresponding real residential or shipping address and then delivers the goods or services to the user." [0014] (pg. 5, lines 11-18 09/693,165)

Virtual

While the Examiner provided prior art to all the steps, the Examiner gives no patentable weight to the following abstract steps which can be performed by a person: step 1 "creating virtual personal information; step 3 "converting the virtual personal information..." since a managing apparatus does not have hardware to perform the converting"; step 4 "notifying the real..."; step 6 seeking confirmation on an approval..."; step 7 "instructing delivery...".

Shiloh, also in the business of teaching real and non-real information, teaches virtual world and virtual information:

"Virtunality will provide you with a fictional user name and fictional user information for your Internet activity. This implementation is intended for extremely privacy-oriented users who would not disclose their real identity to anyone related to the Internet, not even to Virtunality." (pg. 3, para. 1)

"According to another possible implementation (user type "Y" in the attached drawing), your real identity will be disclosed only to Virtunality in the real world, e.g., in person, by mail, by phone, by direct connection, etc. (depending on your level of comfort)." (pg. 3, para. 2). Therefore, Virtuanlity is an entity that receives real personal information.

The sole difference between Junda and the claimed subject matter is that the primary reference does not disclose a virtual world and virtual information including user, address, and city, rather proxy information that can be used online.

Shiloh discloses "virtual" in regards to user information and a virtual world, where such information is used in commerce and for shipping.

Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of

virtual world in Shiloh for proxy information in Junda that includes address and city.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Regarding claim 12:

A system for managing a virtual city space within a virtual world in which commercial transactions occur, comprising:

a manager mapping virtual personal information of a virtual world to real personal information;

“Finally, the software on the proxy agent site 142 updates, in block 206, the user database 144 to include the generated proxy user data and ensure that the generated proxy user data accurately corresponds with the real user data, which is also stored in the database 144 for facilitating translations between the generated proxy user data and the real user data.” [0046] (pg. 13, lines 19-23 of 09/693,165)

(see Virtual below)

a plurality of virtual shops accessible via a network;

“An important feature of the present invention is that the user may utilize the proxy personal information in place of the selected real personal information when making purchases and/or taking delivery of goods or services at both traditional retail outlets and on-line merchant sites.” [0011] (pg. 4, lines 14-17 of 09/693,165)

a commercial transaction being made between a first virtual individual and an arbitrary one of the virtual shops, based on virtual personal information of the first virtual individual;

“An important feature of the present invention is that the user may utilize the proxy personal information in place of the selected real personal information when making purchases and/or taking delivery of goods or services at both traditional retail outlets and on-line merchant sites.” [0011] (pg. 4, lines 14-17 of 09/693,165)

an approval of the transaction is sent by an individual in the real world who made the commercial transaction, based on the virtual personal information; and

“In addition, it was described that a message is generated and sent from the merchant site directly to the user computer for confirming a purchase transaction. However, this is also merely one illustrative example. The purchase confirmation generated at the merchant site might alternatively pass through the proxy agent site before being sent to the user computer. As a result, the proxy agent would be able to maintain a record of the

purchase transaction and store the record in the user database along with the user's real data and proxy data. The user may then access these records for keeping track of his or her purchases made using the proxy user data." [0076] (also pg. 21, lines 17-24 of 09/693,165) Inherent in confirming a purchase is approval of the purchase.

a delivery and/or settlement of an item from the arbitrary one of the virtual shops is made depending on the commercial transaction and the approval, based on the real personal information,

"The present invention also provides the user with a method for effecting the delivery of the goods or services that conceals the user's real residential or shipping address and/or e-mail address from the merchant. In this embodiment of the present invention, the merchant may deliver goods or services in digital form to the user by utilizing the user's proxy e-mail address. Further, the merchant may deliver goods or services in tangible form to the user by providing the user's proxy residential or shipping address to an accepted delivery service, which obtains the user's corresponding real residential or shipping address and then delivers the goods or services to the user." [0014] (pg. 5, lines 11-18)

wherein said virtual personal information has a representation format similar to that of real personal information of a real world, and includes a virtual address in the virtual city space within the virtual world.

"The user's personal information may include, but is not limited to, the user's real name, real residential or shipping address, real e-mail address, and real credit or debit card account number. Before making purchases and/or taking delivery of goods or services, the user obtains proxy personal information for use in place of the user's real personal information during the purchase and/or delivery transactions." [0010] (pg. 4, lines 5-10 of 09/693,165)

(see Virtual below)

Virtual

Junda teaches real information and non-real, proxy information for use with merchants over the internet, where such real and proxy information includes a user, address and city.

Junda does not teach a virtual world with virtual information.

Shiloh, also in the business of teaching real and non-real information, teaches virtual world and virtual information:

"Virtunality will provide you with a fictional user name and fictional user information for your Internet activity. This implementation is

intended for extremely privacy-oriented users who would not disclose their real identity to anyone related to the Internet, not even to Virtunality." (pg. 3, para. 1)

"According to another possible implementation (user type "Y" in the attached drawing), your real identity will be disclosed only to Virtunality in the real world, e.g., in person, by mail, by phone, by direct connection, etc. (depending on your level of comfort)." (pg. 3, para. 2). Therefore, Virtuanlity is an entity that receives real personal information.

The sole difference between Junda and the claimed subject matter is that the primary reference does not disclose a virtual world and virtual information including user, address, and city, rather proxy information that can be used online.

Shiloh discloses "virtual" in regards to user information and a virtual world, where such information is used in commerce and for shipping.

Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of virtual world in Shiloh for proxy information in Junda that includes address and city.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Regarding claim 13

The system as claimed in claim 12, further comprising:
a virtual home of a second virtual individual having a virtual address in the virtual city space, and
a communication being made between the first virtual individual and the second virtual individual, based on the virtual personal information of the first virtual individual.

**The combined references teach a virtual world and virtual identities.
They do not teach communication between virtual individuals.**

Shiloh, in the business of virtual worlds teaches:

User "Y" ("Proposed Model for Virtunality")

"Such services may include an online automatic dating expert (e.g., a "hit-line" generator), an online "famous quote" generator, an online "trivia generator", an online business expert, online automatic translation of "e-language", and/or any other tools that may improve the social skills of interested users." (pg. 6, para. 1)

Also, access to "Chat rooms" ("Proposed Model for Virtunality")

It would have been obvious to one of ordinary skill in the art at the time of invention to include in the virtual world of the combined references the ability of the virtual individuals to communicate with each other since the claimed invention is merely a combination of old elements, and in the combination each element would merely have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claim 16

A method, comprising:
creating virtual information of a virtual user;

Junda teaches:

"Before making purchases and/or taking delivery of goods or services, the user obtains proxy personal information for use in place of the user's real personal information during the purchase and/or delivery transactions."
[0010] (pg. 4, lines 7-10 of 09/693,165)

"If it is determined, for example, that the user 120 is the holder of a credit or debit card issued by the proxy agent 140, payments have been timely made, and there are funds available on the credit or debit card, then the software on the proxy agent site 142 generates, in block 204, unique proxy user data corresponding with the user's real name, real shipping address, real credit or debit card account number, and real e-mail address, and then provides the generated proxy user data to the user 120 for subsequent use." [0044] (pg. 12, lines 28-33 of 09/693,165)

(see Virtual World below)

communicating, via a network, the virtual information of the virtual user to at least one of a plurality of virtual entities within a virtual world, both the virtual user and the plurality of virtual entities representing a real person and real entities;

"An important feature of the present invention is that the user may utilize the proxy personal information in place of the selected real personal information when making purchases and/or taking delivery of goods or services at both traditional retail outlets and on-line merchant sites. By

utilizing the proxy personal information when making purchases, the user can obtain virtually the same level of anonymity that cash-paying customers normally enjoy. Further, by utilizing the proxy personal information when making on-line purchases, the user can avoid any potential leakage of his or her real personal information from the on-line network. Moreover, the user can make on-line purchases utilizing the proxy personal information in the same convenient and easy way that he or she would make such purchases using the real personal information.” [0011] (pg. 4, lines 7-10 of 09/693,165) Therefore, virtual information is communicated via a network to merchant sites.

managing registered information of the virtual user and real user to convert virtual information into real information of a person;
notifying the real personal information to an entity;

“For example, the user 120 registers with the proxy agent 140 according to the procedure shown in FIG. 2. Specifically, the user 120 visits the proxy agent site 142, in block 200, in any conventional manner.” [0041] (pg. 11, lines 33-35)

“Finally, the software on the proxy agent site 142 updates, in block 206, the user database 144 to include the generated proxy user data and ensure that the generated proxy user data accurately corresponds with the real user data, which is also stored in the database 144 for facilitating translations between the generated proxy user data and the real user data.” [0046] (pg. 13, lines 19-23 of 09/693,165)

managing an anonymous commercial transaction between virtual entities in the virtual world on the network by using the virtual information;

“By utilizing the proxy personal information when making purchases, the user can obtain virtually the same level of anonymity that cash-paying customers normally enjoy.” [0011] (pg. 4, lines 17-19 of 09/693,165)

(see Virtual World below)

seeking confirmation of the transaction from the real user; and

“In addition, it was described that a message is generated and sent from the merchant site directly to the user computer for confirming a purchase transaction. However, this is also merely one illustrative example. The purchase confirmation generated at the merchant site might alternatively pass through the proxy agent site before being sent to the user computer. As a result, the proxy agent would be able to maintain a record of the purchase transaction and store the record in the user database along with the user's real data and proxy data. The user may then access these

records for keeping track of his or her purchases made using the proxy user data." [0076] (also pg. 21, lines 17-24 of 09/693,165)

delivering an item involved in the commercial transaction to the real user if the real user confirms the transaction.

"The present invention also provides the user with a method for effecting the delivery of the goods or services that conceals the user's real residential or shipping address and/or e-mail address from the merchant. In this embodiment of the present invention, the merchant may deliver goods or services in digital form to the user by utilizing the user's proxy e-mail address. Further, the merchant may deliver goods or services in tangible form to the user by providing the user's proxy residential or shipping address to an accepted delivery service, which obtains the user's corresponding real residential or shipping address and then delivers the goods or services to the user." [0014] (pg. 5, lines 11-18 of 09/693,165)

Virtual

Junda teaches real information and non-real, proxy information for use with merchants over the internet, where such real and proxy information includes a user, address and city. The proxy information is the same as Applicant's virtual information, where "..."

"....virtual personal information having a representation format similar to that of real personal information of a real world; and converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network." ([0014] of US Pub 2002/0095375)

Junda does not teach a virtual world with virtual information.

Shiloh, also in the business of teaching real and non-real information, teaches virtual world and virtual information:

"Virtunality will provide you with a fictional user name and fictional user information for your Internet activity. This implementation is intended for extremely privacy-oriented users who would not disclose their real identity to anyone related to the Internet, not even to Virtunality." (pg. 3, para. 1)

"According to another possible implementation (user type "Y" in the attached drawing), your real identity will be disclosed only to Virtunality in the real world, e.g., in person, by mail, by phone, by direct connection, etc. (depending on your level of comfort)." (pg. 3, para. 2). Therefore, Virtuanlity is an entity that receives real personal information.

The sole difference between Junda and the claimed subject matter is that the primary reference does not disclose a virtual world and virtual information including user, address, and city, rather proxy information that can be used online.

Shiloh discloses “virtual” in regards to user information and a virtual world, where such information is used in commerce and for shipping.

Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of virtual world in Shiloh for proxy information in Junda that includes address and city.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

While the Examiner provided prior art to all the steps, the Examiner gives no patentable weight to the following abstract steps which can be performed by a person: step 1 “creating virtual personal information; step 3 “converting the virtual personal information...” since a managing apparatus does not have hardware to perform the converting”; step 4 “notifying the real...”; step 6 seeking confirmation on an approval...”; step 7 “instructing delivery...”.

16. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references in section (15) above in further view of US Pub. No. 2001/0034661 to Ferreira (and it's provisional application 60/182282).

Regarding claims 14 and 15:

(claim 14) The system as claimed in claim 13, further comprising: a virtual station through which the first virtual individual can move to another virtual city space.

(claim 15) Thespace system as claimed in claim 12, further comprising: a virtual station through which the first virtual individual can move to another virtual city space.

The combined references teach virtual world with virtual city, they do not teach moving to another virtual city.

Ferreira, also in the business of virtual worlds teaches:

"The virtual city application may also provide virtual travel and tourism features. For example, interest-specific virtual tours may be provided whereby users may take virtual tours based on particular preferences (e.g., jazz in New Orleans). The virtual tours may include visits to parades, museums, clubs, restaurants, or any other suitable event or location." [0020]

Planning your first trip to the San Francisco? Spend some time in VirtuaSanFrancisco first. You can catalog the sites you'd like to see and make all you travel arrangements online in one easy credit card payment. Thinking about taking a job in New York City, but a little intimidated at the prospect of the Big Apple? No sweat-you can spend as much time there as you like before you ever go, wandering the streets you are going to call your own, finding your soon-to-be-favorite hang-out spots, even looking for an apartment. A housewife in Bloomington Indiana might spend her weekends visiting the well-known "Miracle Mile" shopping strip in Chicago. A west coast father might spend hours exploring the east coast neighborhood his daughter will be calling home when she attends college there in the Fall. A young couple might perform their weekend chores buying groceries, lowers, bread, renting videos, paying bills and going to the bank-by walking around their virtual neighborhood rather than their real 'one. (pg. 7, para. 3 of 60/182282)

It would have been obvious to one of ordinary skill in the art at the time of invention to include in the virtual world of the combined references the ability of the virtual individuals to move to another virtual city as the claimed invention is merely a combination of old elements, and in the combination each element would merely have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,073,115 Marshall

U.S. Patent No. 6,476,830 Farmer et al.

U.S. Patent No. 6,910,186 Kim

U.S. Patent No. 7,086,005 **Matsuda**

U.S. Patent No. 6,005,939 **Fortenberry et al.**

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH L. BARTLEY whose telephone number is (571)272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693